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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,712	03/29/2001	Takashi Shinzaki	1075.1156	4094

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT PAPER NUMBER

3627

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/819,712	SHINZAKI, TAKASHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Marissa Thein	3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicants' "Amendment" filed on May 30, 2006 has been considered.

Applicants' remark pertaining to claims 16-18 has overcome the Examiner's claim rejections under 35 USC § 112, second paragraph.

Claims 1, 4, 12, 17 and 65 are amended. Claims 1-18 and 65 remain pending in this application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-6, 11-13, 15 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,807,530 to Shub et al. in view of U.S. Patent No. 6,336,100 to Yamada.**

Regarding claims 1, Shub disclose an e-commerce method for an e-commerce system, which includes a seller's terminal (merchant, col. 1, lines 55-57; col. 2, lines 3-3; Figure 1; col. 3, lines 43-44), a customer's terminal (customer, col. 1, lines 55-57; col. 2, lines 3-5; Figure 1; col. 3, lines 40-44), a payment agent's terminal (payment agency; Figure 1; col. 2, lines 3-5); and commodity delivery means (delivery companies; col. 2, lines 3-5), the method comprising: at the customer's terminal sending an anonymous order (anonymous buy) to the seller's terminal for a commodity via the information

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communication network and designating a non-residential place other than a residential place (alternate address, col. 6, lines 54-56; col. 2, lines 53-57) of the customer as the delivery destination via the communication network (col. 3, lines 9-12; col. 6, lines 43-61), said anonymous order being void of personal identification information (col. 1, lines 60-64; col. 4, lines 25-27); at the seller's terminal assigning transaction identification (ID) information (order number) peculiar to said anonymous order and notifying the customer's terminal of said transaction ID information (col. 6, lines 54-56; col. 2, lines 47-53), requesting the payment agent's terminal for payment for the commodity for which the customer's terminal made the anonymous order (col. 2, lines 49-53; col. 4, lines 40-43; col. 6, lines 50-53), making arrangements to deliver the commodity to the non-residential place using the commodity delivery means (col. 2, lines 53-col. 3, line 3; col. 6, lines 53-61; col. 7, lines 6-9); and at the commodity delivery means transferring the commodity to a receiver for the commodity at the non-residential place by using information void of personal identification information (col. 3, lines 8-12; col. 5, lines 60-64; col. 6, lines 62-col. 7, line 1).

However, Shub does not explicitly disclose the receiver certifying information. Shub discloses a method of enabling a customer to remotely order goods from a merchant and receive the goods without revealing the customer's identity or address to the merchant (col. 1, lines 9-12). The customer identification information need not be disclosed to the merchant or to anyone other than the customer (col. 1, lines 62-64). Shub further teaches a private key/public key pair and a secret encoding key (col. 2, lines 26-28). The public key is used to verify that the label corresponds to the order, the

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identify and address of the customer are not readable by being blinded or encoded (col. 6, line 62-col. 7, line 1). Furthermore, Shub discloses the customer has the option to request the order to be delivered to an alternate address (col. 2, lines 53-55). The goods is delivered to the customer's alternate address and gets the goods using the second bank order number x2 and the number pair (c, t) (col. 5, lines 60-63).

Yamada, on the other hand, teaches an online shopping system, which a customer can designate, addresses or places where he or she wants to have goods delivered (col. 1, lines 19-22). Yamada further teaches the receiver certifying information (col. 2, lines 59-60; col. 3, lines 1-5; col. 3, lines 55-col. 4, line 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Shub, to include the receiver certifying information, as taught by Yamada, in order to deliver the commodity satisfactorily to the customer (Yamada, col. 5, lines 12-13), thus providing an effective delivery system (Yamada, col. 5, lines 28-29).

Regarding claims 2-6, Shub substantially discloses the claimed invention, however, it does not explicitly discloses certification; the receiver certifying information which is created at the sellers' terminal and price information of the transaction, together with the transaction ID information are notified to the customer's terminal; the customer's terminal notifies the payment's agent terminal of the transaction ID information and the price information, which have been notified by the seller's terminal; customer's terminal notifies the seller's terminal of receiver certifying information; a sales slip medium containing said transaction ID information in form of a read-out code;

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and the receiver for the commodity is certified as the authorized receiver, by reading out the transaction ID information of the sales slip medium; the transaction ID information is ciphered with the read-out code as a code key; and the ciphered transaction ID information of the sales slip medium is deciphered using the code key.

Shub discloses a method of enabling a customer to remotely order goods from a merchant and receive the goods without revealing the customer's identity or address to the merchant (col. 1, lines 9-12). Shub further teaches a private key/public key pair and a secret encoding key (col. 2, lines 26-28). Furthermore, Shub discloses the customer has the option to request the order to be delivered to an alternate address (col. 2, lines 53-55). The goods is delivered to the customer's alternate address and gets the goods using the second bank order number x2 and the number pair (c, t) (col. 5, lines 60-63).

Yamada, on the other hand, teaches an online shopping system which a customer can designate addresses or places where he or she wants to have goods delivered (col. 1, lines 19-22). Yamada further teaches the certification (col. 3, line 66 – col. 4, line 3); the receiver certifying information which his created at the sellers' terminal and price information of the transaction, together with the transaction ID information are notified to the customer's terminal (col. 2, lines 59-60; col. 3, lines 1-5; col. 3, lines 55-65); the customer's terminal notifies the payment's agent terminal of the transaction ID information and the price information, which have been notified by the seller's terminal (col. 2, lines 59-60; col. 3, lines 1-5; Figures 11-12); customer's terminal notifies the seller's terminal of receiver certifying information (col. 3, line 55-col. 4, line 4); a sales slip medium containing said transaction ID information in form of a read-out code

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(receipt, Figure 12); and the receiver for the commodity is certified as the authorized receiver, by reading out the transaction ID information of the sales slip medium (col. 3, line 66- col. 4, line 3; col. 5, lines 4-6); the transaction ID information is ciphered with the read-out code as a code key (col. 3, line 66- col. 4, line 3; col. 5, lines 4-6, Figure 12); and the ciphered transaction ID information of the sales slip medium is deciphered using the code key (col. 3, line 66- col. 4, line 3; col. 5, lines 4-6, Figure 12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Shub, to include the certification, as taught by Yamada, in order to deliver the commodity satisfactorily to the customer (Yamada, col. 5, lines 12-13), thus providing an effective delivery system (Yamada, col. 5, lines 28-29).

Regarding claims 11-13 and 15, Shub substantially disclose the claimed invention, however, it does not disclose upon completion of delivery of the commodity of the non-residential place, the seller's terminal notifies the customer's terminal of the completion of the delivery; certification is made as to whether the receiver for the commodity is an authorized receiver, using receiver certification information; notifying the customer's terminal of a status of delivery of the commodity; and notification to the seller's terminal via communication network that the transferring of the commodity has been carried out in the commodity transferring step.

Shub discloses a method of enabling a customer to remotely order goods from a merchant and receive the goods without revealing the customer's identity or address to the merchant (col. 1, lines 9-12). Shub further teaches a private key/public key pair and

a secret encoding key (col. 2, lines 26-28). Furthermore, Shub discloses the customer has the option to request the order to be delivered to an alternate address (col. 2, lines 53-55). The goods is delivered to the customer's alternate address and gets the goods using the second bank order number x2 and the number pair (c, t) (col. 5, lines 60-63).

Yamada, on the other hand, teaches upon completion of delivery of the commodity of the non-residential place, the seller's terminal notifies the customer's terminal of the completion of the delivery (col. 3, lines 43-65); certification is made as to whether the receiver for the commodity is an authorized receiver, using receiver certification information (col. 2, lines 57-65; col. 3, line 66- col. 4, line 3); notifying the customer's terminal of a status of delivery of the commodity (col. 3, lines 46-47); and notification to the seller's terminal via communication network that the transferring of the commodity has been carried out in the commodity transferring step (col. 3, lines 43-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Shub, to include the notification and certification, as taught by Yamada, in order to deliver the commodity satisfactorily to the customer (Yamada, col. 5, lines 12-13), thus providing an effective delivery system (Yamada, col. 5, lines 28-29).

Regarding claim 65, Shub discloses a method for conducting electronic commerce, comprising: receiving an anonymous purchaser order, said anonymous purchaser order being void of personal identification information (col. 4, lines 25-27); and assigning transaction identification information to the anonymous purchase order (abstract; col. 6, lines 44-61); and transferring an item purchased by said purchaser



order using information void of personal identification information (col. 3, lines 8-12; col. 5, lines 60-64; col. 6, lines 62-col. 7, line 1).

However, Shub does not explicitly disclose the receiver certifying information. Shub discloses a method of enabling a customer to remotely order goods from a merchant and receive the goods without revealing the customer's identity or address to the merchant (col. 1, lines 9-12). The customer identification information need not be disclosed to the merchant or to anyone other than the customer (col. 1, lines 62-64). Shub further teaches a private key/public key pair and a secret encoding key (col. 2, lines 26-28). The public key is used to verify that the label corresponds to the order, the identify and address of the customer are not readable being blinded or encoded (col. 6, line 63-col. 7, line 1). Furthermore, Shub discloses the customer has the option to request the order to be delivered to an alternate address (col. 2, lines 53-55). The goods is delivered to the customer's alternate address and gets the goods using the second bank order number  $x_2$  and the number pair (c, t) (col. 5, lines 60-63).

Yamada, on the other hand, teaches an online shopping system, which a customer can designate, addresses or places where he or she wants to have goods delivered (col. 1, lines 19-22). Yamada further teaches the receiver certifying information (col. 2, lines 59-60; col. 3, lines 1-5; col. 3, lines 55-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Shub, to include the receiver certifying information, as taught by Yamada, in order to deliver the commodity

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satisfactorily to the customer (Yamada, col. 5, lines 12-13), thus providing an effective delivery system (Yamada, col. 5, lines 28-29).

**Claims 7-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,807,530 to Shub et al. and U.S. Patent No. 6,336,100 to Yamada as applied to claim 1 above, and further view of U.S. Patent No. 6,236,972 to Shkedy.** Shub and Yamada substantially disclose the claimed invention, however, the combination does not disclose digital signature and biometrics. The combination discloses member discriminating information that discriminates account settlement systems (Yamada, col. 2, lines 59-65). Furthermore, the combination discloses the service provider issues ID cards storing the member discriminating information (Yamada, col. 2, lines 59-65). Shkedy, on the other hand, teaches digital signatures and biometrics (col. 5, lines 3-7).

Therefor, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Shub and Yamada, to include digital signatures and biometrics, as taught by Shkedy, so as to authenticate the customer identification (Shkedy, col. 5, lines 3-4).

**Claim 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,807,530 to Shub et al. and U.S. Patent No. 6,336,100 to Yamada as applied to claim 1 above, and further view of U.S. Patent No. 6,085,170 to Tsukuda.**

Regarding claim 9, Shub and Yamada substantially disclose the claimed invention, however, the combination does not disclose a commodity cabinet. The

combination discloses the delivery of a product to a station where the commodity is kept temporarily (Yamada, col. 3, lines 7-8). Tsukuda, on the other hand, teaches the commodity cabinet (col. 9, lines 38-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Shub and Yamada, to include the commodity cabinet, as taught by Tsukuda, in order to store the goods inside the cabinet so that the customer can receive the goods at anytime (Tsukuda, col. 11, lines 19-24).

**Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,807,530 to Shub et al. and U.S. Patent No. 6,336,100 to Yamada as applied to claim 1 above, and further view of U.S. Patent No. 6, 609,113 to O'Leary et al.** Shub substantially discloses the claimed invention, however, it does not disclose the arrangement to pay a predetermined amount of money periodically to a customer's account established for the payment agent to make payment in behalf of the customer and the payment agent makes a direct debit of a price regarding the purchasing of the commodity in the customer's account. Shub disclose a payment agency which establishes protocols for the exchange of information (col. 6, lines 17-19). The payment agency is the bank and/or credit card company of the customer and can also be a specialized agency where the customer pays cash in exchange for a receipt (col. 4, lines 13-17). O'Leary, on the other hand, teaches the arrangement as recited above (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Shub, to include the payment arrangement, as taught by O'Leary, in order to pay the seller.

**Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,807,530 to Shub et al. and U.S. Patent No. 6,336,100 to Yamada as applied to claim 1 above, and further view of U.S. Patent No. 6,748,365 to Quinlan et al.** Shub substantially discloses the claimed invention, however, it does not disclose the marketing information, discounts and age/sex information. Quinlan, on the other hand, teaches the marketing information, as recited above (col. 3, lines 26-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Yamada, to include the marketing information, as taught by Quinlan, in order to redeem product rebates (Quinlan col. 1, lines 12-13).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 65 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed May 30, 2006 have been fully considered but they are not persuasive.

Applicants remark that Shub does not disclose "transferring the commodity to a receiver for the commodity at said non-residential place by using receiver certifying information void of personal identification information".

The Examiner notes that the combination of Shub and Yamada. Shub discloses the transferring the commodity to a receiver for the commodity at said non-residential place by using information void of personal identification information. Shub discloses a method and apparatus for remote commercial transactions, such that customer identification information needs not to be disclosed to the merchant or to anyone other than the customer (col. 1, lines 60-63). Shub discloses a second agent of the merchant can use the public key to verify that the label corresponds to the order, the identity and address of the customer are not readable by being blinded or encoded (col. 6, line 62 – col. 7, line 1). The goods is delivered to the customer's alternate address and gets the goods using the second bank order number x2 and the number pair (c, t) (col. 5, lines 60-63). The Examiner then turns to Yamada to teach the use of certifying information. Yamada teaches the delivery confirmation (col. 3, lines 62-65). Yamada further teaches collating information recorded on an ID card of a receiver with information indicated on a delivery statement attached to a commodity and passes the commodity to the receiver (col. 3, line 66 – col. 4, line 3).

Such customer identification information needs not to be disclosed to the merchant or to anyone other than the customer; goods is delivered to the customer's alternate address and gets the goods using the second bank order number x2 and the number pair; delivery confirmation; and collating information recorded on an ID card of a receiver with information indicated on a delivery statement attached to a commodity and passes the commodity to the receiver are considered "transferring the commodity to a

receiver for the commodity at said non-residential place by using receiver certifying information void of personal identification information”.

Applicants remark that “claim 1 patentable distinguishes over Shub and Yamada, either alone or in combination”.

As discussed above, the combination of Shub and Yamada discloses claim 1 above.

Applicant remarks that “claim 1 patentable distinguishes over Shub and Yamada.....Shkedy does not cure the deficiencies of Shub and Yamada in regards to claim 1”

As discussed above, the combination of Shub and Yamada discloses claim 1 above. Shkedy was cited for teaching the digital signature and biometrics.

Applicant remarks that “claim 1 patentable distinguishes over Shub and Yamada.....Tsukuda does not cure the deficiencies of Shub and Yamada in regards to claim 1”

As discussed above, the combination of Shub and Yamada discloses claim 1 above. Tsukuda was cited for teaching commodity cabinet.

Applicant remarks that “claim 1 patentable distinguishes over Shub and Tsukuda.....O’Leary does not cure the deficiencies of Shub and Tsukuda in regards to claim 1”

As discussed above, the combination of Shub and Yamada discloses claim 1 above. Tsukuda was cited for teaching commodity cabinet. O’Leary was cited for teaching the arrangement to pay a predetermined amount of money.

Applicant remarks that "claim 1 patentable distinguishes over Shub .....Quinlan does not cure the deficiencies of Shub in regards to claim 1"

As discussed above, the combination of Shub and Yamada discloses claim 1 above. Quinlan was cited for teaching the marketing information.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot  
August 2, 2006

 8/2/06  
**F. RYAN ZEENDER**  
**PRIMARY EXAMINER**